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IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Nils-Fredrik KAISER et al. Conf.: 5761
Appl. No.: 10/014,562 Group: 1639
Filed: December 14, 2001 Examiner: M. Tran
For: ORGANIC REACTIONS WITH CO GENERATING
MATERIALS

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 2, 2003

Sir:

In reply to the Restriction Requirement dated April 2, 2003,
the following remarks are respectfully submitted in connection with
the above-identified application.

REMARKS

Claims 1-36 are pending in the present application.

The Examiner has required election in the present application
between:

Group I, claims 1-15, 18 and 20-36, drawn to a method of
performing a one-pot organic reaction, classified in class 436,
subclass 145;

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Group II, claims 15-18 and 35-36, drawn to a method for preparing a chemical library, classified in class 435, subclass 3; and

Group III, claim 19, drawn to a kit for organic reactions, classified in class 435, subclass 287.1.

Applicants traverse this election and withdrawal thereof is respectfully requested. The restriction requirement appears arbitrary and to follow no cohesive logic in designation of the groups. For example, the claims listed in Groups I and II overlap significantly. By issuing a restriction requirement, the Examiner takes the position that the claims of each group are drawn to patentably distinct inventions. However, the Examiner has placed the same claims in two different groups. Notably, claims 15, 18 and 35-36 appear in both Groups I and II. In addition, it is not clear to Applicants on what basis claims 16 and 17 were designated as being part of Group II, but not part of Group I, since the same non-catalyzing compounds are recited in claims 16 and 17, as are recited in claims 2 and 3.

The claims of Groups I and II are all linked by the common inventive steps of preparing a reaction mixture containing a non-catalysing solid or liquid CO releasing compound, a non-metal substrate compound and a metal catalyst; and exposing said reaction mixture to an energy source to release carbon monoxide from the CO releasing compound, wherein carbon atoms of the released carbon

monoxide form a bond with the non-metal substrate compound. As such, the restriction is believed to be improper.

With regard to claim 19, Applicants do not believe that it would be an undue burden to search the kit recited in this claim, since the same reactants have to be searched with regard to the claimed methods.

However, for the purpose of examination of the present application, Applicants elect, with traverse, Group I, claims 1-15, 18 and 20-36.

The Examiner further required the following elections of species.

- a. non-catalyzing solid
- b. non-catalyzing CO releasing compound
- c. metal catalyst (Groups I and II, only)
- d. non-metal substrate (Groups I and II, only)
- e. additional reactant (Groups I and II, only)
- [f]. energy source (Group II, only).

Applicants strongly traverse this election as being completely improper and withdrawal thereof with consideration of all the species is respectfully requested.

1) With regard to "a. non-catalyzing solid" and "b. non-catalyzing CO releasing compound", the Examiner appears to have misinterpreted the claims as separately requiring a) a non-

catalyzing solid and b) a non-catalyzing CO releasing compound. However, the reaction of claim 1 contains a non-catalyzing CO releasing compound, which may be a solid or a liquid. See, for example, the first paragraph under the "Summary of the Invention."

2) As a second point, Applicants note that there is no list of non-metal substrates from which to make an election. As such, an election of species of non-metal substrate material is impossible.

Applicants request that the Examiner review and reconsider the restriction and election of species.

However, with traverse, Applicants make the following election of species, where possible.

- a. non-catalyzing solid - molybdenum hexacarbonyl ($\text{Mo}(\text{CO})_6$);
- b. non-catalyzing CO releasing compound - formamide (HCONH_2);
- c. metal catalyst (Groups I and II, only) - Pd catalyst;
- d. non-metal substrate (Groups I and II, only) - not possible to make an election because no list of species is disclosed;
- e. additional reactant (Groups I and II, only) - claims amended to delete "additional reactant" therefore election is moot;
- [f]. energy source (Group II, only) - Group I elected, therefore election not required.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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